

TSMC-00-823



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May 31, 2002

To: Commissioner of Patents and Trademarks

Washington, D.C. 20231

Attn: Art Unit 2827 - A. Chambliss

From: George O. Saile, Reg. No. 19,572

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Poughkeepsie, N. Y., 12603

TECHNOLOGY CENTER 2800
JUL - 1 2002

#5
Ext. 1 mo.
Election
J. McMillan
RECEIVED
7/18/02

Subject: | Serial No.: 09/912,739 07/26/01 |

Pei-Haw Tsao et al.

GROOVED HEAT SPREADER FOR STRESS
REDUCTION IN IC PACKAGE

| _ Art Group: 2827 A. Chambliss _ |

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Restriction or Election Requirement in the Office Action dated 05/14/02. In that Office Action, restriction was required to one of two stated

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on June 17, 2002.

Stephen B. Ackerman, Reg.# 37761

Signature/Date

 6/17/02

Inventions under 35 U.S.C. 121. The Inventions stated are Group I - Claims 1-6 and 11-16 to a process, classified in Class 438, subclass 122 and Group II - Claims 7-10 and 17-21 to a product, classified in Class 257, subclass 706.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-6 and 11-16 drawn to a process classified in Class 438, subclass 122. This election is made with traverse of the requirement under 37 C.F.R.1.143 for the reasons given in the following paragraphs.

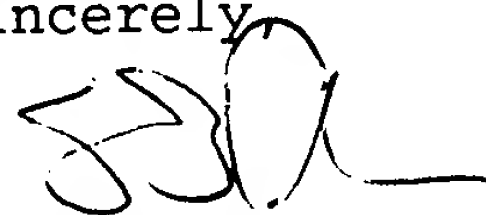
The Examiner is respectfully requested to reconsider the Requirement for Restriction given in the Office Action. The Examiner gives the reason for the distinctness of the two inventions as (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). However, upon reading the product Claims against the process Claims one can readily see that the product Claims are directed to "a heat spreader for a semiconductor package" and the process Claims are directed to "a method of creating a heat spreader for use in a semiconductor package", it is necessary to obtain claims in both the product and method claim language. The method Claims necessarily use the product and vice versa. The field of search must necessarily cover both the method class/subclass

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438/122 and products class 257/706 in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, the product of claim 17 can be made by another and materially different process such as a process without providing an underfill for the semiconductor device and attaching the semiconductor device to the semiconductor device mounting support by wiring bonding instead of using solder balls", is very speculative and really has nothing to do with the Claims as presented in this Patent Application. Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of a second Patent Application upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement and the Allowance of the present Patent Application is requested.

Sincerely,

A handwritten signature in dark ink, appearing to be 'SBA', written over a horizontal line.

Stephen B. Ackerman, Reg.# 37761